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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,519	06/05/2002	Burrrhus Lang	2008_0518	5973

513 7590 06/25/2010  
WENDEROTH, LIND & PONACK, L.L.P.  
1030 15th Street, N.W.,  
Suite 400 East  
Washington, DC 20005-1503

EXAMINER
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BOCKELMAN, MARK

ART UNIT	PAPER NUMBER
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3766

NOTIFICATION DATE	DELIVERY MODE
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06/25/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ddalecki@wenderoth.com  
coa@wenderoth.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/030,519	<b>Applicant(s)</b> LANG ET AL.	
	<b>Examiner</b> Mark W. Bockelman	<b>Art Unit</b> 3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 37-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-7-2009</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37-52 use a negative intended use limitation that renders the claim indefinite. How an element is to be used involves future knowledge of the use of the device by the user which makes the claim indefinite. How a device will not be used makes the claim even more so indefinite since it requires the future knowledge of everyone.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 37-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Canadian patent 1,219,642.

Canadian patent 1,218,642 shows several embodiments of electrode configurations. In figure 3, 3 potential electrode elements 30, 33, 36 are shown that extend to a tab 32 with three uncontacted elements. The elements are each capable of being contactable by an electrode or can be consider “free” of a contacting element

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depending upon the intended use. Applicant's circular rings as shown in their drawings are all capable of being contacted by an electrical energy applicator. Thus, the examiner designates which elements are contactable in terms of intended use in interpreting applicant's claims. In claims 16-21, 23-28, 30 and 32 the examiner considers the contactable conductor to be electrode 30 and the uncontacted conductor to either elements 33 and/or 36. Regarding claims 22, the examiner considers the inner uncontacted conductor 33 to extend into the space between contactable conductors 30 and 36. Regarding claim 31, the examiner considers the conductors to be formed in alternative (interleaved) surfaces (figure 4) wherein starting with the most inner conductor, every other conductor is contactable and the others are uncontacted. The method step would be inherent since the method does not require the uncontacted metal surface to remain unconnected to the electrical stimulator. If applicant were to amend the method claims to state that the uncontacted conductor is not connected electrically to the electrical stimulator during electrical stimulation the examiner would look favorably upon the claims.

Claims 37-39, 41, 52 are rejected under 35 U.S.C. 102(b) as being anticipated by King USPN 4,282,886.

King shows an electrode 14 with a contactable surface that engages tab 14a. A piece of conductive foil 16a surrounds the electrode. The device would inherently include circuitry for heat applications.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Canadian patent 1,219,642. The claim reads upon the intermediate configuration of hooking up the electrode to the device of use wherein one contact is connected and the other not. This is not regarded as patentable subject matter over the Canadian patent.

Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over King USPN 4,282,886. To have placed the King electrode against the tissue to test the functioning of the device prior to removing the outer conductor for permanent attachment would have been an obvious procedure.

Claims 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Canadian patent 1,219,642. To have used the Canadian patent in a bipolar configuration or a monopolar configuration wherein only the central electrode is used would have been obvious.

### ***Response to Arguments***

Applicant's arguments filed 3-4-2010 have been fully considered but they are not persuasive. Applicant's arguments are the same as they have been. Applicant wants to claim his invention using negative intended use clauses. Moreover, the claims use comprising language, thus the claims allow for the ring portion of the conductors of the Canadian patent to be the current equalizing surface, free of contacts, while the extending tab is considered a separate element.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark W. Bockelman whose telephone number is (571) 272-4941. The examiner can normally be reached on Monday - Friday 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on (571) 272 -4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark W Bockelman/  
Primary Examiner, Art Unit 3766